

## **REMARKS**

### **Claim Rejections**

Claims 8-11 are rejected under 35 U.S.C. § 102(e) as being anticipated by Barsun et al. (U.S. 6,707,675). Claim 13 is rejected under 35 U.S.C. §103(a) as being unpatentable over Barsun et al. in view of McCullough (U.S. 6,367,541). Claim 12 is rejected under 35 U.S.C. §103(a) as being unpatentable over Barsun et al. in view of Wyler et al. (U.S. 6,401,807).

It is noted that the reference to Barsun et al. was initially cited by the Examiner in the outstanding Final Office Action. Thus, this Amendment represents Applicant's initial opportunity to respond to the rejections based upon this reference.

### **Drawings**

It is noted that no Patent Drawing Review (Form PTO-948) was received with the outstanding Office Action. Thus, Applicant must assume that the drawings are acceptable as filed.

### **Claim Amendments**

By this Amendment, Applicant has amended claims 8 and 11 of to this application. It is believed that the amended claims specifically set forth each element of Applicant's invention in full compliance with 35 U.S.C. § 112, and define subject matter that is patentably distinguishable over the cited prior art, taken individually or in combination.

The primary reference to Barsun et al. teaches an EMI containment device including a heat sink (130) having a first surface (132), a second surface (134, and a plurality of fins (136).

Barsun et al. do not teach each of the plurality of first heat zone vertical plates have a height that is higher than a height of each of the plurality of second heat zone vertical plates and each of the plurality of first heat zone vertical plates have a bottom in a same plane as a bottom of each of the plurality of second heat zone vertical plates; the plurality of heat zones includes one first heat zone and two second heat zones; the plurality of heat zones includes two first heat zones and one

second heat zone; each first top horizontal plate and each second top horizontal plate includes a rectangular hole; nor do Barsun et al. teach the plurality of heat zones are formed by bending a metal plate.

It is axiomatic in U.S. patent law that, in order for a reference to anticipate a claimed structure, it must clearly disclose each and every feature of the claimed structure. Applicant submits that it is abundantly clear, as discussed above, that Barsun et al. do not disclose each and every feature of Applicant's amended claims and, therefore, could not possibly anticipate these claims under 35 U.S.C. § 102. Absent a specific showing of these features, Barsun et al. cannot be said to anticipate any of Applicant's amended claims under 35 U.S.C. § 102.

The secondary reference to McCullough teaches a heat sink assembly (100) having a heat dissipating member (102) with peaks (104) and valleys (106), and is cited for teaching metal fins.

McCullough does not teach each of the plurality of first heat zone vertical plates have a height that is higher than a height of each of the plurality of second heat zone vertical plates and each of the plurality of first heat zone vertical plates have a bottom in a same plane as a bottom of each of the plurality of second heat zone vertical plates; the plurality of heat zones includes one first heat zone and two second heat zones; the plurality of heat zones includes two first heat zones and one second heat zone; nor does McCullough teach each first top horizontal plate and each second top horizontal plate includes a rectangular hole.

The secondary reference to Wyler et al. teaches a folded fin heat sink (10) having ridges (12), openings (16), and depressed areas (18).

Wyler et al. do not teach each of the plurality of first heat zone vertical plates have a height that is higher than a height of each of the plurality of second heat zone vertical plates and each of the plurality of first heat zone vertical plates have a bottom in a same plane as a bottom of each of the plurality of second heat zone vertical plates; the plurality of heat zones includes one first heat zone and two second heat zones; the plurality of heat zones includes two first heat zones and one second heat zone; nor do Wyler et al. teach each first top horizontal plate and each second top horizontal plate includes a rectangular hole.

Even if the teachings of Barsun et al., McCullough, and Wyler et al. were combined, as suggested by the Examiner, the resultant combination does not suggest: each of the plurality of first heat zone vertical plates have a height that is higher than a height of each of the plurality of second heat zone vertical plates and each of the plurality of first heat zone vertical plates have a bottom in a same plane as a bottom of each of the plurality of second heat zone vertical plates; the plurality of heat zones includes one first heat zone and two second heat zones; the plurality of heat zones includes two first heat zones and one second heat zone; nor does the combination suggest each first top horizontal plate and each second top horizontal plate includes a rectangular hole.

It is a basic principle of U.S. patent law that it is improper to arbitrarily pick and choose prior art patents and combine selected portions of the selected patents on the basis of Applicant's disclosure to create a hypothetical combination which allegedly renders a claim obvious, unless there is some direction in the selected prior art patents to combine the selected teachings in a manner so as to negate the patentability of the claimed subject matter. This principle was enunciated over 40 years ago by the Court of Customs and Patent Appeals in In re Rothermel and Waddell, 125 USPQ 328 (CCPA 1960) wherein the court stated, at page 331:

The examiner and the board in rejecting the appealed claims did so by what appears to us to be a piecemeal reconstruction of the prior art patents in the light of appellants' disclosure. ... It is easy now to attribute to this prior art the knowledge which was first made available by appellants and then to assume that it would have been obvious to one having the ordinary skill in the art to make these suggested reconstructions. While such a reconstruction of the art may be an alluring way to rationalize a rejection of the claims, it is not the type of rejection which the statute authorizes.

The same conclusion was later reached by the Court of Appeals for the Federal Circuit in Orthopedic Equipment Company Inc. v. United States, 217 USPQ 193 (Fed.Cir. 1983). In that decision, the court stated, at page 199:

As has been previously explained, the available art shows each of the elements of the claims in suit. Armed with this information, would it then be non-obvious to this person of ordinary skill in the art to coordinate these elements in the same manner as the claims in suit? The difficulty which attaches to all honest attempts to answer this question can be attributed to the strong temptation to rely on hindsight while undertaking this evaluation. It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of non-obviousness in a court of law.

In In re Geiger, 2 USPQ2d, 1276 (Fed.Cir. 1987) the court stated, at page 1278:

We agree with appellant that the PTO has failed to establish a *prima facie* case of obviousness. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination.

Applicant submits that there is not the slightest suggestion in either Barsun et al., McCullough, or Wyler et al. that their respective teachings may be combined as suggested by the Examiner. Case law is clear that, absent any such teaching or suggestion in the prior art, such a combination cannot be made under 35 U.S.C. § 103.

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Neither Barsun et al., McCullough, nor Wyler et al. disclose, or suggest a modification of their specifically disclosed structures that would lead one having ordinary skill in the art to arrive at Applicant's claimed structure. Applicant hereby respectfully submits that no combination of the cited prior art renders obvious Applicant's amended claims.

**Summary**

In view of the foregoing, Applicant submits that this application is now in condition for allowance and such action is respectfully requested. Should the Examiner not be of the opinion that this case is in condition for allowance, it is requested that this amendment be entered for the purposes of appeal, since it represents Applicant's initial opportunity to respond to the rejections based on Barsun et al.

Should any points remain in issue, which the Examiner feels could best be resolved by either a personal or a telephone interview, it is urged that Applicant's local attorney be contacted at the exchange listed below.

Respectfully submitted,

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